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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,981	06/27/2003	Robert Keane	MPJ-D2	6395
37420	7590	08/20/2007	EXAMINER	
VISTA PRINT USA, INC. ATTN: PATENT COUNSEL 95 HAYDEN AVENUE LEXINGTON, MA 02421			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE DELIVERY MODE	
			08/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,981	KEANE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 June 2007.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____.

### **DETAILED ACTION**

1. Claims 1-8 have been examined. Application 10/608,981 (PRODUCT PRICING SYSTEM AND METHOD) has a filing date 06/27/2003 is a division of 09557571 (Pat. 6650433)(04/25/2000) and foreign priority 01/25/2000.

#### ***Response to Amendment***

2. In response to Non Final Rejection filed 03/12/2007, the Applicant filed an Amendment on 06/12/2007, which amended claims 3 and 4. Applicant's amendment overcame the Section 112 rejection.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan (US 6,173,274).

Claim 1, Ryan teaches:

A computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create

an electronic product design (see col 12, lines 22-35) and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement (see col 9, lines 10-25)

Claim 2, Ryan teaches:

The method of claim 1 wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template (see col 9, lines 10-25; see figure 3)

Claim 3, Ryan teaches:

The method of claim 1 wherein the user must pay a fee to have the advertisement removed (see col 9, lines 10-25; col 10, lines 5-15)

Claim 5, Ryan teaches:

The method of claim 1 wherein the electronic product design is the design of a product that the user desires to be produced in physical form and wherein the method further comprises offering to produce the physical product for the user at a first price if the advertisement appears on the produced product (see col 9, lines 10-25; col 10, lines 5-15); and

offering to produce the physical product for the user at a second price if the advertisement does not appear on the produced product, the second price being greater than the first price (see col 9, lines 10-25; col 10, lines 5-15).

Claim 7, Ryan teaches:

The method of claim 5 wherein the electronic product design is the design of a product intended to be printed and the physical product is a quantity of printed copies of the printed product (see figure 1, item 17).

**Claim 8, Ryan teaches:**

A computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user, the method comprising offering to produce the physical product at a first price if advertising not provided by the user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced (see col 9, lines 10-25; col 10, lines 5-15), and

offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design, the first price being lower than the second price (see col 9, lines 10-25; col 10, lines 5-15).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274).

Claim 4, Ryan does not expressly teach:

The method of claim 1 wherein the tools are provided *by a business* to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools. However, Official Notice is taken that it is old and well known in the promotion art that manufacturers pay to insert their ads in flyers or printed papers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Ryan's postage meter manufacturers (*i.e.* business) would be motivated to pay users for inserting said manufacturers' ads into said users' envelopes in order to give said users an incentive to participate in said manufacturers' system.

As per claim 6, Ryan does not expressly teach:

The method of claim 5 wherein the first price is free. However, Official Notice is taken that it is old and well known in the promotion art that advertisers offer consumers products or services for free when said consumers accept to view or display advertisements in said products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers in the Ryan's system would subsidize certain printing jobs by offering certain printing for free, as it is old and well known to offer user free products when said users are willing to view or display advertisements in said products.

***Response to Arguments***

5. Applicant's arguments filed 06/12/2007 have been fully considered but they are not persuasive. The Applicant argues that Ryan does not disclose a "product design tool

Art Unit: 3622

that allow a user to create a product design" because there is no indication that the Ryan user is allowed to view the electronic design of the envelope or modify the design to control the font, color, size or any other feature related to the design. The Examiner answer that the Applicant is arguing about limitation not stated in the claims. Nowhere, in Applicant's claims is recited that a product design means modifying the font, color, size.

The Applicant argues that that Ryan does not teach that the advertisement is not provided by the user. The Examiner answers that Ryan teaches that the advertisement is provided by the third party advertiser (see col 9, lines 10-25). Therefore, contrary to Applicant's argument, Ryan teaches Applicant's limitation.

The Applicant argues that Ryan does not teach a "template". The Examiner answers that Ryan figure 3 can be construed as a "template" as it shows a product which has fixed and variable content for the purpose of expedite printing.

The Applicant argues with respect to claim 8 that in Ryan the design is created by the printer but not by the user. The Examiner answers that the user approved the design of the envelope prior to printing said envelope (see col 12, lines 22-35). Therefore, contrary to Applicant's argument, Ryan teaches Applicant's limitation.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra  
August 11, 2007

  
JACQUELINE ALVAREZ  
ART EXAMINER